

1 MICHAEL J. BETTINGER (State Bar No. 122196)  
DOUGLAS B. GREENSWAG (*PRO HAC VICE*)  
2 ANUP TIKKU (State Bar No. 184612)  
PRESTON GATES & ELLIS LLP  
3 55 Second Street, Suite 1700  
San Francisco, CA 94105  
4 Phone: (415) 882-8200  
5 Facsimile: (415) 882-8220  
mikeb@prestongates.com  
6 dgreenswag@prestongates.com  
anupt@prestongates.com  
7 Attorneys for Plaintiff  
SPANSION LLC.

8 JONATHAN C. DICKEY, SBN 088226  
9 STEVEN J. JOHNSON, SBN 121568  
GIBSON, DUNN & CRUTCHER LLP  
10 1881 Page Mill Road  
Palo Alto, California 94304  
11 Telephone: (650) 849-5300  
Facsimile: (650) 849-5333  
12 jdickey@gibsondunn.com  
sjjohnson@gibsondunn.com  
13 Attorneys for Defendant,  
MACRONIX AMERICA, INC.  
14 and Specially Appearing for Defendant,  
15 MACRONIX INTERNATIONAL CO.

16 UNITED STATES DISTRICT COURT  
17 NORTHERN DISTRICT OF CALIFORNIA  
18 SAN FRANCISCO DIVISION

18 SPANSION LLC, a  
19 Delaware corporation,

Plaintiff,

**Case No. C 06-1733 MJJ**

20  
21 v.

**REVISED STIPULATED  
PROTECTIVE ORDER**

22  
23 MACRONIX INTERNATIONAL CO., LTD., a  
Taiwan corporation, and MACRONIX  
24 AMERICA, INC. a California corporation,  
25 Defendants.

**STIPULATED PROTECTIVE ORDER**

IT IS HEREBY ORDERED that the following Protective Order be entered in this matter and that the parties shall follow the procedures set forth below with respect to information, documents, or things produced in this litigation:

1. This Protective Order shall be applicable to and govern all depositions, documents, information or things produced in response to requests for production of documents, answers to interrogatories, responses to requests for admissions and all other discovery taken pursuant to the Federal Rules of Civil Procedure, as well as testimony adduced at trial or other hearings, matters in evidence and other information that the disclosing party designates as "CONFIDENTIAL" or "ATTORNEYS' EYES ONLY" hereafter furnished, directly or indirectly, by or on behalf of any party or any non-party witness in connection with this action. As used herein, "disclosing party" shall refer to the parties to this action and to third parties who give testimony or produce documents or other information.

2. Subject to Section 12 hereof, the following information may be designated as "CONFIDENTIAL": any trade secret or other confidential research, design, development, financial, or commercial information contained in any document, discovery response or testimony, or any other information which a party in good faith believes should be treated as "CONFIDENTIAL" and is properly subject to protection under Federal Rules of Civil Procedure 26(c);

3. Subject to Section 12 hereof, the following information may be designated as "ATTORNEYS EYES ONLY": any trade secret or other confidential research, design, development, or commercial information contained in any document, discovery response, or deposition testimony that is entitled to a higher level of protection due to its commercial sensitivity, or any other information which a party in good faith believes should be treated as "ATTORNEYS EYES ONLY" and is properly subject to protection under Federal Rules of Civil Procedure 26(c).

4. A disclosing party may also designate materials as "CONFIDENTIAL" or "ATTORNEYS' EYES ONLY" if it contains information that the disclosing party, in good faith, believes is confidential or proprietary to a third-party. Counsel for the parties may not designate any materials

1 “CONFIDENTIAL” without first making a good faith determination that protection under Federal  
2 Rules of Civil Procedure 26(c) is warranted. Material designated “CONFIDENTIAL” or  
3 “ATTORNEYS’ EYES ONLY” shall be used by the parties to this litigation solely for the purpose  
4 of conducting this litigation, and not for any other purpose whatsoever.

5 5. Disclosing parties shall designate “CONFIDENTIAL” or “ATTORNEYS’ EYES ONLY”  
6 information as follows:

7 (a) In the case of discovery responses and the information contained therein, designation  
8 shall be made by placing the following legend on every page of any such document prior to  
9 production: “CONFIDENTIAL” or “ATTORNEYS’ EYES ONLY.” Except as provided in  
10 paragraph fourteen (14), in the event that a party inadvertently fails to stamp or otherwise designate  
11 a document or other information as “CONFIDENTIAL” or “ATTORNEYS’ EYES ONLY” at the  
12 time of its production, that party shall have five (5) business days after such production to so stamp  
13 or otherwise designate the document or other information.

14 (b) In the event that either party elects to produce documents for inspection only pursuant  
15 to FRCP 34(a), all original documents produced for inspection shall be treated as “ATTORNEYS’  
16 EYES ONLY” for a period not to exceed five (5) business days after the receiving party inspecting  
17 the documents has indicated the documents it desires to be copied. After a receiving party inspecting  
18 the documents has indicated the documents it desires to be copied, and before such copies are  
19 provided to the requesting party, the producing party shall have a reasonable time, not to exceed the  
20 aforementioned five (5) business days, to review the copied documents and designate them as  
21 “CONFIDENTIAL” or “ATTORNEYS’ EYES ONLY” pursuant to the terms of this Order.

22 (c) In the case of depositions, designation of the portion of the transcript (including  
23 exhibits) that contains CONFIDENTIAL or ATTORNEYS’ EYES ONLY information shall be  
24 made by a statement to such effect on the record in the course of the deposition or, upon review of  
25 such transcript, by counsel for a party within five (5) business days after counsel’s receipt of the  
26 transcript.  
27  
28

1 (d) Transcripts of depositions will not be filed with the Court unless it is necessary to do  
 2 so for purposes of motion hearings, trial, or other matters. If a deposition transcript is filed and if it  
 3 contains CONFIDENTIAL or ATTORNEYS' EYES ONLY information the transcript shall bear the  
 4 appropriate legend on the caption page and shall be filed under seal.

5 (e) Any CONFIDENTIAL or ATTORNEYS' EYES ONLY information produced in a  
 6 non-paper media (e.g., videotape, audiotape, computer disk, etc.) may be designated as such by  
 7 labeling the outside of such non-paper media as "CONFIDENTIAL" or "ATTORNEYS' EYES  
 8 ONLY." In the event a receiving party generates any "hard copy," transcription, or printout from  
 9 any such designated non-paper media, such party must stamp each page "CONFIDENTIAL" or  
 10 "ATTORNEYS' EYES ONLY" and the hard copy, transcription or printout shall be treated as it is  
 11 designated.

12 6. If any information designated CONFIDENTIAL or ATTORNEYS' EYES ONLY is filed or  
 13 submitted to the Court, it shall be delivered sealed in an envelope or container to the Clerk of the  
 14 Court in accordance with United States District Court, Northern District of California Civil Local  
 15 Rule 79-5, and shall not be available for public inspection and shall not be opened absent further  
 16 order of the court. The sealed envelope or container shall be marked with the case title, case number  
 17 and title of the paper which contains the information or material designated as CONFIDENTIAL or  
 18 ATTORNEYS' EYES ONLY and a statement substantially in the form of:

19 "CONFIDENTIAL [or ATTORNEYS' EYES ONLY] –DOCUMENT FILED UNDER SEAL  
 20 PURSUANT TO STIPULATED PROTECTIVE ORDER – NOT TO BE OPENED EXCEPT BY  
 21 ORDER OF THE COURT."

22 7. Disclosure of all CONFIDENTIAL information shall be limited to:

23 (a) The outside attorneys working on this action, on behalf of any party, and any  
 24 paralegal assistants, stenographic and clerical employees working under the direct supervision of  
 25 such counsel;  
 26  
 27  
 28

1 (b) Designated in-house counsel or officers Robert Melendres and Raymond Fritz for  
2 Spansion and Billie Chen and Cecil Liu for defendants, and any paralegal assistants, stenographic  
3 and clerical employees working under the direct supervision of such counsel or officers.

4 (c) Officers of the Court and supporting personnel or officers of any appellate court to  
5 which an appeal may be taken in this litigation or in which review is sought, including necessary  
6 stenographic and clerical personnel (e.g. court reporters);

7 (d) Other qualified reporters taking and videographers recording testimony involving  
8 such information and necessary stenographic and clerical personnel thereof;

9 (e) Any person who was an author or recipient of the CONFIDENTIAL information  
10 prior to the commencement of this litigation, but if the person is not an employee of the party to  
11 which the CONFIDENTIAL information belongs, such person may not retain a copy of such  
12 information;

13 (f) Any person of whom testimony is taken regarding the CONFIDENTIAL information,  
14 except that if the person is not an employee of the party to which the CONFIDENTIAL information  
15 belongs, such person may only be shown copies of CONFIDENTIAL information during his/her  
16 testimony, and may not retain a copy of such CONFIDENTIAL information;

17 (g) Any person who is expressly retained by any outside attorney described in paragraph  
18 7(a) to assist in preparation of this action for trial, who is not employed by, affiliated with (whether  
19 as a consultant or otherwise), controlled by, agents of, or materially interested in any party or any  
20 competitor of any party, with disclosure only to the extent necessary to perform such work;

21 (h) The employees of the parties who are required to work directly on this litigation, with  
22 disclosures only to the extent necessary to perform such work.

23 8. Information designated as "ATTORNEYS' EYES ONLY" shall be used solely for the  
24 purposes of this litigation between the parties hereto. "ATTORNEYS' EYES ONLY" information  
25 shall not be disclosed, except by the prior written consent of the disclosing party or third party, or  
26 pursuant to an order of this Court, to any person other than the following:  
27  
28

1 (a) The outside attorneys working on this action on behalf of any party, and any  
2 paralegal assistants, stenographic and clerical employees working under the direct supervision of  
3 such counsel.

4 (b) A maximum of two attorneys or officers from the in-house legal or intellectual  
5 property department of any party who are working directly on this action, and any paralegal  
6 assistants, stenographic and clerical employees working under the direct supervision of such counsel  
7 or officers. The parties initially designate such attorneys or officers as follows: Robert Melendres  
8 and Raymond Fritz for Plaintiff, and Billie Chen and Cecil Liu for Defendants. In the event a party  
9 wishes to substitute a new person for one of the persons listed above, the party shall disclose the  
10 name, job title, and job responsibilities of the substitute person to the opposing party, and provide  
11 the opposing party an opportunity to object. If there is no objection, the substitution may be made.  
12 If there is an objection, the parties shall meet and confer, and if unable to resolve the dispute, tender  
13 the issue to the Court for decision.

14 (c) Officers of the Court and supporting personnel or officers of any appellate court to  
15 which any appeal may be taken in this litigation or in which review is sought, including necessary  
16 stenographic and clerical personnel (e.g. court reporters).

17 (d) Other qualified reporters taking and videographers recording testimony involving  
18 such information and necessary stenographic and clerical personnel thereof;

19 (e) Any person who is an author or recipient of the "ATTORNEYS EYES ONLY"  
20 information prior to the commencement of this litigation, but if the person is not an employee of the  
21 party to which the ATTORNEYS EYES ONLY information belongs, such person may not retain a  
22 copy of such information.;

23 (f) Any person who is expressly retained by any outside attorney described in paragraph  
24 8(a) to assist in preparation of this action for trial, who is not employed by, affiliated with (whether  
25 as a consultant or otherwise), controlled by, agents of, or materially interested in any party or any  
26 competitor of any party, with disclosure only to the extent necessary to perform such work.  
27  
28

1 9. Nothing herein shall restrict any party's use of its own CONFIDENTIAL or ATTORNEYS'  
2 EYES ONLY information.

3 10. Prior to disclosure of any CONFIDENTIAL information which belongs to an opposing party  
4 to any persons in paragraphs 7(b), 7(e), 7(f), 7(g), and 7(h), and prior to disclosure of any  
5 ATTORNEYS' EYES ONLY information which belongs to an opposing party to any persons in  
6 paragraphs 8(b), 8(e) and 8(f) the procedure set forth in paragraph 11 shall be followed.

7 11. Prior to the disclosure of CONFIDENTIAL or ATTORNEYS' EYES ONLY information  
8 which belongs to an opposing party to persons in paragraphs 7(b), 7(e), 7(f), 7(g), 7(h), 8(b), 8(e) or  
9 8(f), the outside counsel in this litigation for the party making the disclosure shall advise each person  
10 that the information is CONFIDENTIAL or ATTORNEYS' EYES ONLY, can only be discussed  
11 with persons authorized by this Protective Order to view the material and can only be used for  
12 purposes of this litigation. Counsel shall retain, but need not disclose, a copy of a signed  
13 undertaking of each person to whom disclosure is made under paragraphs 7(b), 7(e), 7(f), 7(g) and  
14 7(h). Counsel shall retain and disclose to the other party a copy of a signed undertaking of each  
15 person to whom disclosure is made under paragraph 8(b) 8(e) and 8(f), except that the disclosure of  
16 the signed undertaking with respect to retained experts may be made at the time such experts are  
17 designated in the litigation. The written undertaking, which shall be in the form of Exhibit A hereto,  
18 shall acknowledge that he or she has read and understands this Protective Order, and agrees to  
19 comply with this Protective Order.

20 12. A party shall not be obligated to challenge the propriety of a CONFIDENTIAL or  
21 ATTORNEYS' EYES ONLY designation at the time made, and failure to do so shall not preclude a  
22 subsequent challenge thereto. In the event that any party to this litigation disagrees at any stage of  
23 these proceedings with such designation, such party shall provide to the producing party written  
24 notice of its disagreement with the designation. Within five (5) business days after receiving any  
25 written notice, the producing party shall respond to the challenging party identifying in writing the  
26 bases for the asserted designation. The producing party shall bear the burden of showing that its  
27 asserted designation is warranted. The parties shall first try to dispose of such dispute in good faith  
28



1 on an informal basis. If the dispute cannot be resolved, the party challenging the designation may  
2 request appropriate relief from the Court, but in any event, such relief from the Court shall not be  
3 requested before ten (10) business days after the producing party is served with said written notice.

4 13. Failure of counsel to designate or mark any document, thing, or testimony as  
5 CONFIDENTIAL or ATTORNEYS' EYES ONLY information as provided above shall not  
6 preclude the disclosing party from thereafter in good faith making such designation and requesting  
7 the receiving party to so mark and treat such documents and things so designated even after the  
8 expiration of the "five (5) business days" designation period described in paragraph 5(a). The  
9 receiving party, however, shall incur no liability for disclosures made prior to notice of such  
10 designations.

11 14. If CONFIDENTIAL or ATTORNEYS' EYES ONLY information is disclosed to any person  
12 other than in the manner authorized by this Protective Order, the person responsible for the  
13 disclosure shall immediately bring all pertinent facts relating to such disclosure to the attention of  
14 counsel for all parties, without prejudice to other rights and remedies of any party, and shall make  
15 every effort to prevent further disclosure by it or by the person who was the recipient of such  
16 information.

17 15. The Clerk of the Court is directed to maintain under seal all documents and all transcripts of  
18 deposition testimony filed with this Court in this litigation by any party that are, in whole or in part,  
19 designated as CONFIDENTIAL or ATTORNEYS' EYES ONLY, including all pleadings,  
20 deposition transcripts, exhibits, discovery responses or memoranda purporting to reproduce or  
21 paraphrase such information. The person filing such material shall designate to the Clerk that all or  
22 a designated portion thereof is subject to this Protective Order and is to be kept under seal, except  
23 that upon the failure of the filing party to so designate, any party may do so.

24 16. In the event that any CONFIDENTIAL or ATTORNEYS' EYES ONLY information is used  
25 in any court proceeding in connection with this litigation, it shall not lose its CONFIDENTIAL or  
26 ATTORNEYS' EYES ONLY status through such use, and the parties shall take all steps reasonably  
27 required to protect its confidentiality during such use.  
28



1 17. The inadvertent production in the course of discovery in this action of any document or  
2 information (whether or not designated as CONFIDENTIAL or ATTORNEYS' EYES ONLY) shall  
3 not be deemed to waive whatever attorney-client privilege, work product protection or other  
4 privilege or immunity that would otherwise attach to the document or information produced or to  
5 other documents or information, as long as the producing party or person, promptly after discovery,  
6 notifies the other party or parties of the claim of privilege or other protection or immunity. Upon  
7 such notice, the other party or parties shall promptly destroy all copies of the documents or  
8 information referred to, including any summaries thereof, and notify the producing party that it has  
9 done so. Such destruction and notice shall not constitute an acknowledgment that the claimed  
10 document or information is in fact privileged or entitled to protection or immunity and does not  
11 preclude the receiving party from seeking to compel production of the materials for reasons other  
12 than its inadvertent production..

13 18. Within 60 days after the final termination of this litigation, counsel for each Party shall return  
14 to the originating source, or certify in writing the destruction of, all CONFIDENTIAL and  
15 ATTORNEYS' EYES ONLY information of the opposing party or parties and all copies thereof;  
16 provided, however, outside counsel of record for each party may retain attorney work product  
17 containing such information, and may petition the Court to retain one copy of each document for  
18 good cause shown.

19 19. Nothing herein shall prevent any party from moving the court for modification of this  
20 Protective Order for good cause.

21 20. Except as specifically provided herein, the terms, conditions, and limitations of this  
22 Protective Order shall survive the termination of this action.

23 21. The Court shall have jurisdiction to enforce the terms of the order for a period of six months  
24 after final termination of the action.  
25  
26  
27  
28

22. Nothing herein shall be deemed to constitute a waiver of any objection a producing party may have to any request for production of documents or other requested discovery. Nothing herein shall prevent any party from objecting to production of documents or objecting to other discovery requests on any available grounds, or from seeking alternative protective orders from the Court.

IT IS SO ORDERED this 8/21/06 day of August, 2006



HONORABLE JUDGE MARTIN J. JENKINS

PRESTON GATES & ELLIS LLP

By                     /s/                     August 7, 2006  
Anup Tikku  
Attorneys for Plaintiff  
Spansion LLC.

GIBSON, DUNN & CRUTCHER LLP

By:                     /s/                     August 7, 2006  
Mark H. Lyon  
Attorneys for Defendants Macronix International Co., LTD.  
and Macronix America, Inc.

EXHIBIT A  
UNDERTAKING

I acknowledge that I, \_\_\_\_\_ (Name), of  
\_\_\_\_\_  
\_\_\_\_\_ (Place and Position of Employment),  
am about to receive CONFIDENTIAL or ATTORNEYS EYES ONLY information supplied by  
\_\_\_\_\_ (Party). I certify that I understand that such information will  
be provided to me pursuant to the terms and restrictions of the PROTECTIVE ORDER of  
\_\_\_\_\_, 2006, in Spansion LLC v. Macronix International Co., LTD. and  
Macronix America, Inc., Cause No. C 06-1733 MJJ, in the United States District Court for the  
Northern District of California. I further represent that I have been given a copy of and have read  
that PROTECTIVE ORDER, that I agree to be bound by all of its applicable terms, and that I submit  
to the jurisdiction of the United States District Court for the Northern District of California for  
matters relating to the use of information designated CONFIDENTIAL or ATTORNEYS' EYES  
ONLY pursuant to this Undertaking and the Protective Order. I also understand that documents  
and/or information bearing any CONFIDENTIAL or ATTORNEYS' EYES ONLY designation, and  
all copies, summaries, notes and other records that may be made regarding such documents and/or  
information, shall be disclosed to no one other than persons qualified under the PROTECTIVE  
ORDER to have access to such information.

I understand and acknowledge that violation of this Undertaking or the PROTECTIVE  
ORDER may be punishable by Contempt of Court.

DATED this \_\_\_\_\_ day of \_\_\_\_\_, 2006.

By: \_\_\_\_\_